

REMARKS/ARGUMENTS

The Office Action dated May 22, 2008 has been reviewed and carefully considered. Claims 1, 2, 6-10 and 13-20 are pending. Claims 3-5, 11 and 12 have been cancelled without prejudice. Reconsideration of the above-identified application in light of the enclosed amendments and remarks is respectfully requested.

In the Office Action, claims 1-5, 8-12 and 15-20 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Maeda et al. (U.S. Patent 6,556,546) in view of Na et al. (U.S. Patent No. 6,504,996). It is respectfully submitted that independent claims 1, 8, 15 and 18 are patentable over Maeda and Na for at least the following reasons.

Amended independent claim 1 has been amended to recite “A digital broadcast method for supporting *user* DVD recording...*wherein the navigation data includes at least one of, in-stream data and out-stream data, data for searching and data for reproduction control and data for generating menus...*”

Applicants can find nothing Maeda and Na that teaches the above limitations. Amended independent claim 8, 15 and 18 recite similar limitations.

The Office Action points to Na at col. 4, lines 31-39 as teaching these features (these features having been originally present in claims 4 and 5). Applicants respectfully disagree. In these sections Na simply describes what information is provided in a standard or “issued” DVD (e.g. one that is prerecorded with content) in the MPEG

standard, and not a user recorded DVD. See also the present invention specification, page 1, lines 11-25. Nothing in Maeda or Na teaches to provide this navigation data in a digital broadcast for a user DVD recording.

The Office Action further indicates that it would have been obvious to use broadcast/MPEG standard to transmit streams as taught by Na in order to reproduce standard DVD information with ease. However, it is not seen how Na's use "standard DVD information" in contrast to user recorded DVD information provides the motivation to combine as asserted in the Office Action, without improper hindsight by "use[ing] the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention," see *In Re Denis Rouffet*, 47 USPQ.2d 1453, 1457-58 (Fed. Cir. 1998). Although, Na teaches the use of standard DVD information for an issued DVD, and motivation has been provided by the Office Action to show reasons that the skilled artisan, confronted with the same problems as the inventor would select the elements from the cited prior art references for combination in the manner claimed, see *Id*, in particular, a digital broadcast method for supporting *user* DVD recording...*wherein the navigation data includes at least one of, in-stream data and out-stream data, data for searching and data for reproduction control and data for generating menus...*

A claimed invention is *prima facie* obvious when three basic criteria are met. First, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference

or to combine the teachings therein. Second, there must be a reasonable expectation of success. And, third, the prior art reference or combined references must teach or suggest all the claim limitations.

Having shown that in Maeda and Na, alone or in combination, fail to disclose each and every element claimed, applicant submits that the reason for the Examiner's rejection of claims 1, 8, 15 and 18 has been overcome and can no longer be sustained. Applicant respectfully requests reconsideration, withdrawal of the rejection and allowance of claims 1, 8, 15 and 18.

In the Office Action, claims 6, 7, 13 and 14 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Maeda in view of Na and in further view of Rotem et al. (U.S. Patent No. 7,043,484).

With regard to the dependent claims 2, 6, 7, 9, 10, 13, 14, 16, 17, 19 and 20 these claims ultimately depend from one of the independent claims, which have been shown to be allowable in view of the cited references. Accordingly, claims 2, 6, 7, 9, 10, 13, 14, 16, 17, 19 and 20 are also allowable by virtue of their dependence from an allowable base claim.

For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Thomas J. Onka', is written over a horizontal line.

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